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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,445	12/20/2001	Neil R. Wilson	M 6794 HST/AUTO/CS	1496

7590

05/06/2004

Stephen D. Harper
Law Department
Suite 200
2500 Renaissance Blvd.
Gulph Mills, PA 19406

EXAMINER

WEBB, GREGORY E

ART UNIT

PAPER NUMBER

1751

DATE MAILED: 05/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/027,445	WILSON, NEIL R.	
	Examiner	Art Unit	
	Gregory E. Webb	1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 1-20 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 32-34 is/are allowed.
- 6) ☒ Claim(s) 21-28 is/are rejected.
- 7) ☒ Claim(s) 29-31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/7/03, 9/3/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-20, drawn to processes of removing paint, classified in class 134, subclass 38.
 - II. Claims 21-34, drawn to compositions containing glycol ethers, classified in class 510, subclass 506.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the compositions of group II can be used for purposes beyond removing paint. For example Sato et al (US 5,279,760) teaches composition meeting instant claim 21 but fails to meet instant claim 1 as the compositions of Sato are intended not for removing paint but instead for cleaning gas turbine air compressors. Thus the restriction is proper.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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4. During a telephone conversation with Stephen D. Harper on 5/4/04 a provisional election was made with traverse to prosecute the invention of group II, claims 21-34. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

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reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 21, 22, and 24-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Murphy (US 3,615,827).

3. Murphy teaches compositions containing water, a water-soluble alkoxyated aromatic alcohol and a water soluble base (see example B).

4. Murphy teaches alkoxyated aromatic alcohols containing two alkoxy groups including diethylene glycol monophenyl ether and dipropylene glycol monophenyl ether (see col. 3, lines 60-75).

5. Murphy teaches the use of various bases including alkali metal hydroxide in amounts ranging from 50-97% of the composition (see col. 2, lines 26-33).

6. Murphy teaches the use of the glycol ether in the accelerator part of the composition. Murphy teaches the accelerator portion of the composition to be from 1-12% of the net composition. Murphy teaches the glycol ether to be at most 50% of the composition. Thus the maximum concentration of the glycol ether would be 6%.

7. Claims 21-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Sato et al (US 5,279,760).

8. Sato teaches in claims 1-2 a composition containing 30-60% solvent, 30-60% surfactant, and 30-99% water.

9. Sato teaches in claim 5 various suitable glycol ethers including triethylene glycol monophenyl ether.

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10. In examples 2, 4-6, and 8-9 (see cols. 7-8) Sato uses anionic surfactants which use alkanolamines as the water-soluble base. Although salts are formed to create these surfactants, these salts would disassociate when added to water and would thus meet the limitation of an alkanolamine.

11. Claims 21-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Murphy (US 5,391,234).

12. Murphy teaches in claim 1 a composition containing (A) at least 10% alkali metal silicates, (C) ethers of phenols and amines, and (E) surfactants.

13. Murphy teaches the accelerator (C) to be 0.5-25% of the composition. Murphy teaches various components in the accelerator including the preferred triethanolamine (see col. 7, lines 30-45) in amounts ranging from 5-75% of the net accelerator composition. Murphy further teaches the second ingredient, the remainder of the accelerator (i.e. 25-95% of the accelerator composition) in the accelerator to be phenol ethers including diethylene glycol monophenyl ether and dipropylene glycol monophenyl ether (see col. 7, lines 45-65). Thus the amount of triethanolamine would range from 0.25%-18.75% and the glycol ether would be 0.125%-23.75%.

14. Claims 21-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Kitano et al (US 6,241,912).

15. Kitano teaches compositions containing a solvent and a surfactant (see claim 1). Kitano teaches various suitable solvents including diethylene glycol monophenyl ether, triethylene glycol monophenyl ether and triethylene glycol monobenzyl ether (see claim 1).

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16. Kitano teaches the addition of anionic surfactants neutralized by various water soluble bases including monoethanolamine (see col. 3, lines 50-60).

Allowable Subject Matter

17. Claims 29-31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

18. Claim 29 requires the combination of the alkanolamine with alkali metal silicates and alcohols with 3-10 oxyethylene moieties. The triethylene and tripropylene glycol ethers are not as common in the art. The specific combination of these glycol ethers with the alkanolamine and the silicate was not taught in the prior art.

19. Claim 34 is allowed as it requires the longer chain glycol ether and very specific amounts of alkanolamine. Such combination are not found in the prior art of record. Nor would it have been obvious to have modified these references to obtain these specific weight percentages.

20.

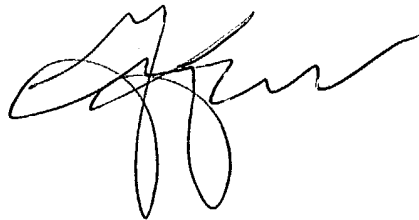
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory E. Webb whose telephone number is 571-272-1325.

The examiner can normally be reached on 9:00-17:30 (m-f).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Gregory E. Webb', with a stylized, flowing script.

Gregory E. Webb
Primary Examiner
Art Unit 1751

gw